

STATEMENT OF SUBSTANCE OF THE TELEPHONE CONFERENCE

As a preliminary matter, Applicant's representative would like to thank the Examiner for courtesies extended in the telephone conference conducted on June 14, 2006, in which the Examiner kindly clarified that Ranta was being included in the rejections of claims 9 and 12, and claims 11 and 13-15, based solely on the rejection of the independent claim 1. That is, Ranta is not relied upon for the features of dependent claims 9 and 12, or dependent claims 11 and 13-15.

REMARKS

An excess claim fee payment letter is submitted herewith for two (2) excess independent claims.

Claims 1-20 are all the claims presently pending in the application.

Applicant gratefully acknowledges that **claims 5-7, 19, and 20** would be **allowable** if rewritten in independent form. While Applicant believes that all of the claims are in condition for immediate allowance, to expedite prosecution, allowable claims 5, 6, and 19 are rewritten in independent form. However, Applicant respectfully submits that all of the claims (i.e., claims 1-20) should be allowable, for the reasons set forth below. No new matter is added.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicant specifically states that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 1-4, 8, 10, and 16-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zhang et al. (U. S. Pat. Pub. No. 2003/0224830) in view of Ranta (U.S. Pat. No. 6,751,485).

Claims 9 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zhang et al. in view of Ranta, as applied to claim 1 above, and further in view of Paik et al. (US Pat. No. 6,675,008).

Claims 11, and 13-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zhang et al. in view of Ranta, as applied to claim 1 above, and further in view of Mun et al. (U.S. Pat. Pub. No. 2003/0022659).

These rejections are respectfully traversed in the following discussion.

I. THE CLAIMED INVENTION

Conventional portable telephone sets have been adapted to permit telephone calls by reading out a telephone number of the opposite side of communication registered in a telephone diary stored in a memory part based on the corresponding names or titles of the opposite side. Other conventional portable telephone sets include a camera part in which images of the faces of the opposite side of communication can be picked up by the camera part and is stored in the memory part such that the face image is displayed on the display of the telephone set along with the opposite side data as name or telephone number.

In conventional portable telephone set communication systems, it is presently an indispensable convenient function to accumulate non-response call arrival having not been responded to so as to permit a non-response call arrival history based on these data to be displayed on the display as desired by the user operation.

However, the conventional portable telephone sets, such as disclosed by Zhang, have not disclosed or suggested displaying the image of the face or the like of the opposite side of communication in the case of utilizing the above-mentioned non-response call arrival history or stored messages.

The claimed invention, on the other hand, provides a portable communication terminal set which, like a portable telephone set or a PDA, which can display the image of the face or the like of the opposite side even in the case of utilizing non-response call arrival history or stored messages.

II. THE PRIOR ART REJECTIONS

A. Claims 1-4, 8, 10, and 16-18:

Claims 1-4, 8, 10, and 16-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zhang in view of Ranta.

In the present Office Action, the Examiner acknowledges that Zhang does not disclose or suggest that the memory part includes a communication history data representing the history of communication executed by the radio part, as claimed. However, the Examiner alleges that Ranta makes up for the deficiencies of Zhang by disclosing a portable communication terminal (mobile telephone 38, see Fig. 3, column 7, lines 19-21) wherein the memory part (memory 54, see Fig. 3, col. 7, lines 35-36) includes a communication history data representing the history of communication executed by the radio part (the memory 54 of the mobile terminal 38 stores phone numbers of recently made, received and missed calls, see Fig. 3, column 2, lines 52-57 and col. 7, lines 35-43). The Examiner alleges that it would have been obvious to

combine Ranta into the system of Zhang for the benefit of alerting a user of an incoming call (see Office Action at page 4).

However, Applicant submits that the Examiner has not provided any support for the stated motivation, and therefore, has not established a *prima facie* case of obviousness, as a procedural matter. Moreover, Applicant respectfully submits that there are features of the claimed invention which are not disclosed or suggested by Zhang and Ranta, either individually or in combination. Therefore, Applicant traverses this rejection.

First, as mentioned above, Applicant submits that the Examiner has not provided any support for the stated motivation, and therefore, has not established a *prima facie* case of obviousness, as a procedural matter.

Applicant respectfully submits that the Examiner's statement merely amounts to a conclusory statement by the Examiner. The Examiner has not explained *how* or *why* the recently made, received, and missed calls stored in the memory of Ranta would have motivated the ordinarily skilled artisan to modify Zhang such that "*an image of image data corresponding to a pertinent opposite side party of communication is displayed on the display part under control by the control part in correspondence to at least one of a call arrival in the radio part and the acceptance of operation by the operation part based on combination data stored in the memory part*", as recited in claim 1 (emphasis added).

Second, even assuming *arguendo* that a proper motivation were established for making such a combination, there are features of the claimed invention which are not disclosed or suggested by Zhang and Ranta, either individually or in combination.

For example, Ranta discloses a mobile telephone in which phone numbers of recently made, received or missed phone calls are stored (16) in a memory of the mobile

telephone and associated with a distinctive alerting sound. An incoming call matching (34) one of the stored phone numbers causes the distinctive alerting sound to be sounded unless the phone number matches (26) a number prestored by the user and associated with an individual or organization known to the user (e.g., see Ranta at Abstract).

As the Examiner points out, Ranta discloses a mobile device such as a mobile telephone 38 having a memory 54, which is shown in FIG. 3, for storing phone numbers of recently made, received or missed phone calls. Also included in the mobile telephone 38 is a means 56 for associating the stored phone numbers of recently made, received or missed phone calls with a distinctive alerting sound generally indicative of such phone calls.

Ranta further discloses that, if a first comparison step 24 of FIG. 2 is found by the means 62 to be a match, the distinctive alerting sound indicated by the step 28 is sounded by a means 64 for sounding alerting sounds associated with particular individuals or parties that have been prestored and associated by the user. On the other hand, if the steps 32, 34 result in a match, the step 36 is executed by means for sounding a distinctive alerting sound associated with recently made, received or missed calls whether it be a generic sound or individual sounds associated with each type of recent call.

That is, Ranta merely changes the alerting sound based on whether the incoming call matches a particular individual or party that has been prestored and associated by the user, or if not, then based on whether the incoming call matches a recently made, received or missed call (e.g., see Ranta at column 7, lines 51-63).

On the other hand, Zhang merely discloses storing the current incoming telephone number. Zhang also discloses displaying an image or telephone number of only one incoming call (i.e., the current call being received by the phone).

Applicant submits that merely incorporating the recently made, received or missed calls of Ranta still would not teach or suggest the claimed invention.

That is, if the memory 54 of Ranta, including the recently made, received or missed calls, were incorporated into Figure 3 of Zhang, as alleged by the Examiner, it is unclear what, if anything, Zhang would do differently.

Indeed, if the incoming number does not correspond to a number found in the look-up table, Zhang would not display a different image in the way that Ranta sounds a distinctive alerting sound.

Thus, since the Examiner has not provided any support for the stated motivation, the Examiner's alleged combination appears to be based on impermissible hindsight-based analysis, since neither Zhang nor Ranta would provide any motivation for doing that which the Applicant has done. Instead, the Examiner appears to combine Zhang and Ranta in view of the teachings of the claimed invention, not based on the teachings of Zhang, Ranta, or the art in general.

The claimed invention, on the other hand, provides a portable communication terminal set which can display the image of the face or the like of the opposite side even in the case of utilizing non-response call arrival history or stored messages, since the communication history of the portable communication terminal set is stored by the memory part.

Claim 1

For example, independent claim 1 recites, *inter alia*, a portable communication terminal set including:

a memory part for storing data including image data representing a plurality of images, opposite side party data representing a plurality of opposite side parties of communication,

combination data representing the correspondence relation between the image data and opposite side party data and communication history data representing the history of communication executed by the radio part, ... wherein:

an image of image data corresponding to a pertinent opposite side party of communication is displayed on the display part under control by the control part in correspondence to at least one of a call arrival in the radio part and the acceptance of operation by the operation part based on combination data stored in the memory part.

As mentioned above, Zhang and Ranta, either individually or in combination, do not disclose or suggest all of the features of claim 1.

Independent claim 16 recites somewhat similar features as claim 1, and therefore, should be allowable for somewhat similar reasons.

Claims 2-4, 8, 10, 17, and 18

Applicant submits that dependent claims 2-4, 8, 10, 17, and 18 are patentable over Zhang by virtue of their dependency from claim 1 and 16, as well as for the additional features recited therein. That is, Applicant respectfully submits that there are features of the claimed invention which are not disclosed or suggested by Zhang and Ranta, either individually or in combination. Therefore, Applicant traverses the rejection of these claims.

For example, claim 3 recites, *inter alia*:

wherein non-response call arrival history data concerning non-response call arrivals not responded in the radio part are stored as communication history data in the memory part under control by the control part, and the image of image data corresponding to the opposite side party of communication concerning the newest non-response call arrival among the image data stored in the memory part, is displayed on the display part based on the non-response call arrival history data and combination data stored in the memory part (emphasis added).

The Examiner has not shown anywhere in Zhang or Ranta where the “*image of image data corresponding to the opposite side party of communication concerning the newest non-response call arrival among the image data stored in the memory part, is displayed*” (emphasis added).

It is noted that each and every feature of the claims must be shown.

Thus, Zhang and Ranta, either individually or in combination, clearly do not disclose or suggest all of the features of claim 3.

As another example, claim 4 recites, *inter alia*:

wherein non-response call arrival history data concerning non-response call arrivals not responded in the radio part are stored as communication history data in the memory part under control by the control part, and the image of image data corresponding to the opposite side party of communication concerning the first non-response call arrival subsequent to the instant of execution of the newest operation on the operational part among the image data stored in the memory part, is displayed on the display part based on the non-response call arrival history data and combination data stored in the memory part (emphasis added).

The Examiner has not shown anywhere in Zhang or Ranta where the “*the image of image data corresponding to the opposite side party of communication concerning the first non-response call arrival subsequent to the instant of execution of the newest operation on the operational part among the image data stored in the memory part, is displayed*” (emphasis added).

Again, each and every feature of the claims must be shown.

Thus, Zhang and Ranta, either individually or in combination, clearly do not disclose or suggest all of the features of claim 4.

Similar to claim 3, claim 17 recites, *inter alia*:

wherein non-response call arrival history data concerning non-response call arrivals not responded in the radio part are stored as communication history data in the memory part under control by the control part, and the image of image data corresponding to the opposite side party of communication concerning the newest non-response call arrival among the image data stored in the memory part, is displayed on the display part based on the non-response call arrival history data and combination data stored in the memory part (emphasis added).

The Examiner has not shown anywhere in Zhang or Ranta where the “the image of image data corresponding to the opposite side party of communication concerning the newest non-response call arrival among the image data stored in the memory part, is displayed” (emphasis added).

It is noted that each and every feature of the claims must be shown.

Thus, Zhang and Ranta, either individually or in combination, clearly do not disclose or suggest all of the features of claim 17.

Similar to claim 4, claim 18 recites, *inter alia*:

wherein non-response call arrival history data concerning non-response call arrivals not responded in the radio part are stored as communication history data in the memory part under control by the control part, and the image of image data corresponding to the opposite side party of communication concerning the first non-response call arrival subsequent to the instant of execution of the newest operation on the operational part among the image data stored in the memory part, is displayed on the display part based on the non-response call arrival history data and combination data stored in the memory part (emphasis added).

The Examiner has not shown anywhere in Zhang or Ranta where the “the image of image data corresponding to the opposite side party of communication concerning the first non-response call arrival subsequent to the instant of execution of the newest

operation on the operational part among the image data stored in the memory part, is displayed" (emphasis added).

Again, each and every feature of the claims must be shown.

Thus, Zhang and Ranta, either individually or in combination, clearly do not disclose or suggest all of the features of claim 4.

For the foregoing reasons, Zhang and Ranta, either individually or in combination, do not disclose or suggest all of the features of the claimed invention. Therefore, the Examiner is requested to reconsider and withdraw this rejection and to permit claims 1-4, 8, 10, and 16-18 to pass to immediate allowance.

B. Claims 9 and 12:

Claims 9 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Zhang, Ranta, and Paik.

As mentioned above, in the telephone conference conducted on June 14, 2006, the Examiner kindly clarified that Ranta was being included in the rejections of claims 9 and 12, and claims 11 and 13-15, based solely on the rejection of the independent claim 1. That is, Ranta is not relied upon for the features of dependent claims 9 and 12, or dependent claims 11 and 13-15.

Applicant notes that, in the previous Amendment, Applicant clearly pointed out that Paik does not disclose or suggest the claimed features for which it is relied upon as teaching.

However, the present Office Action clearly has not responded to or answered the substance of Applicant's traversal position with respect to Paik.

It is noted that where Applicant traverses any rejections, the Examiner should, if he repeats the rejection, take note of the Applicant's argument and answer the substance of it (see M.P.E.P. § 707.07(f)).

Thus, the present Office Action fails to comply with M.P.E.P. § 707.07(f).

Accordingly, Applicant respectfully requests that the Examiner issue a new, non-final Office Action which properly answers the substance of Applicant's traversal position, which is reiterated below, for the Examiner's convenience.

To reiterate, Applicant submits that dependent claims 9 and 12 are patentable over Zhang and Ranta by virtue of their dependency from claim 1, as well as for the additional features recited therein.

Applicant also notes that the Examiner relies on Paik for disclosing "*trimming*" the picture, as recited in claims 9 and 12. However, as the Examiner points out, Paik discloses a picture "compression technique" and "converting the size" of a picture (e.g., see Paik at column 5, lines 23-40).

The ordinarily skilled artisan clearly would know and understand that "compression techniques" and "converting the size" of an image are not the same as "*trimming*" a picture, as claimed.

For example, claim 9 recites, *inter alia*:

wherein under control by the control part a predetermined part of an image of image data corresponding to a pertinent opposite side party of communication among the image data stored in the memory part is trimmed and extracted responsive to the operation of the operational part, and the image extracted by the trimming is used as an image to be displayed on the display part in an enlarged scale to fit the display area of the display part (emphasis added).

That is, the claimed invention trims a part of the stored image, extracts that part of the stored image, and then enlarges the extracted part of the stored image and displays the extracted part of the stored image to fit the display area of the display part, as shown, for example, in Figure 7.

Hence, according to the claimed invention, an image of a person can be trimmed such that the part of the stored image which includes the person's face is extracted from the stored image. The extracted part of the image can then be enlarged to fit the display area of the display part so that the displayed part of the image which includes the person's face can be easily recognized by the user of the apparatus (e.g., see specification at page 14, lines 10-26; see also Figure 7).

Claim 12 somewhat similarly recites that "*a predetermined part*" of the image is contracted and the contracted part of the image is displayed.

In comparison, Paik merely compresses the data, or scales the overall image to be larger or smaller.

Paik does not disclose or suggest "*trimming*" a part of the image, "*extracting*" the part of the image, and then displaying the extracted part of the image to fit the display.

For the foregoing reasons, Applicant respectfully submits that there are features of claims 9 and 12 which clearly are not disclosed or suggested by Zhang, Ranta, and Paik, either individually or in combination.

Therefore, the Examiner is requested to reconsider and withdraw this rejection and to permit claims 9 and 12 to pass to immediate allowance.

Alternatively, the Examiner is requested to properly answer the substance of Applicant's traversal position in accordance with M.P.E.P. § 707(f) in a new, non-final Office Action.

C. Claims 11 and 13-15:

Claims 11 and 13-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Zhang, Ranta, and Mun.

The Examiner alleges that the combination of Zhang, Ranta, and Mun disclose or suggest all of the features of the claimed invention.

Applicant respectfully submits, however, that there are features of the claimed invention which are not disclosed or suggested by Zhang, Ranta, and Mun, either individually or in combination. Therefore, Applicant traverses this rejection.

Applicant submits that dependent claims 11 and 13-15 are patentable over Zhang and Ranta by virtue of their dependency from claim 1, as well as for the additional features recited therein. Moreover, Applicant submits that Mun does not make of for the above deficiencies of Zhang and Ranta, and indeed, is not relied upon for such features.

For the foregoing reasons, Zhang, Ranta, and Mun, either individually or in combination, do not disclose or suggest all of the features of the claimed invention. Therefore, the Examiner is requested to reconsider and withdraw this rejection and to permit claims 11 and 13-15 to pass to immediate allowance.

III. CONCLUSION

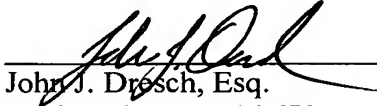
In view of the foregoing, Applicant submits that claims 1-20, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: July 3, 2006


John J. Dresch, Esq.
Registration No. 46,672

Sean M. McGinn, Esq.
Registration No. 34,386

**MCGINN INTELLECTUAL PROPERTY
LAW GROUP, PLLC**
8321 Old Courthouse Road, Suite 200
Vienna, Virginia 22182-3817
(703) 761-4100
Customer No. 21254